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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/534,194  | 04/12/2006  | Frank Miller         | 10191/3672          | 9976             |
| 26646   | 7590        | 02/05/2009           | EXAMINER            |                  |
| KENYON & KENYON LLP<br>ONE BROADWAY<br>NEW YORK, NY 10004 |             |                      |                     | HWU, DAVIS D     |
| ART UNIT  |             | PAPER NUMBER         |                     |                  |
| 3752  |             |                      |                     |                  |
| MAIL DATE   |             | DELIVERY MODE        |                     |                  |
| 02/05/2009  |             | PAPER                |                     |                  |

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/534,194

Filing Date: April 12, 2006

Appellant(s): MILLER ET AL.

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Clifford A. Ulrich  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 03 November 2008 appealing from the Office action mailed 02 May 2008.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

5,409,169

Saikalis et al.

4-1995

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 102***

1. Claims 19, 20, 28-30, 32, 33, 35, 36, and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Saikalis et al.

Saikalis et al. shows a dosing device comprising at least one metering device to meter fuel into a metering conduit (see Figures 8 and 11), a nozzle body adjoining the metering conduit (Figure 11), the nozzle body including at least one spray discharge opening 115 that opens into a metering chamber, the nozzle body including a downstream support element 107 having a swirl insert (A and B) arranged on a spray discharge side, the discharge opening 115 arranged in the swirl insert, wherein the swirl insert includes a seat element B having the discharge opening 115 and a swirl element A arranged upstream from the seat element B. Claim 20 is a statement of intended use since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. The swirl element includes a continuous opening 109 wherein the opening is at least partially closed off by an insert 104 as recited in claims 29 and 30. Saikalis et al. also shows an intermediate element (the bottom of A as see in Figure 9) as recited in claim 35.

***Claim Rejections - 35 USC § 103***

2. Claims 21-26, 31, 34, 37, 38, 40, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saikalis et al.

Saikalis et al. also discloses a tubular supply tube (see in Figure 11) connected downstream in a hydraulically sealed manner to the tubular support element. The tube being welded would have been a matter of design choice since welding various parts together is well known in the art and the swirl insert being joined in a hydraulically sealed manner to the support element as recited in claim 26 and making parts detachable from each other as recited in claim 37 would also have been matters of design choice. Saikalis et al. also discloses an air inlet 105 as recited in claim 38. Regarding claim 40, it would have been obvious to one having ordinary skill in the art at the time the invention was made to operate the fuel pressure as the recited pressure, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involve only routine skill in the art and regarding claim 41, a change in the size of a component is generally recognized as being within the level of ordinary skill in the art.

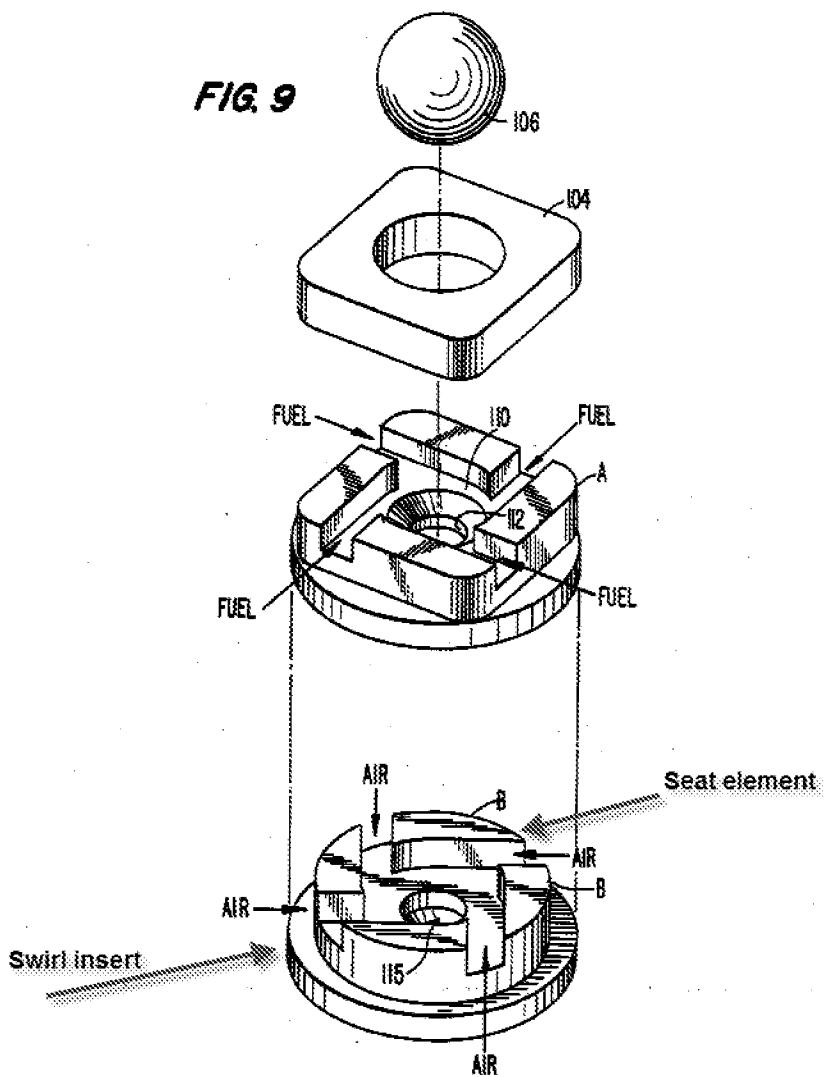
#### **(10) Response to Argument**

**Regarding the argument of the rejection of claims 19, 20, 28-30, 32, 33, 35, 36, and 39 under 35 USC 102(b)**

Saikalis et al. identically shows all of the claimed features of claim 19 including the feature of at least one seat element having at least one spray discharge opening as claimed in claim 19 because the swirl insert B comprises a seat section (see marked up Figure 9 generated by examiner below) on which a swirl element A sits, and therefore the seat section of swirl insert B meets the claimed limitation of a “seat element”, and since the spray discharge opening runs through the swirl insert B, the limitation of “a

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seat element having the at least one spray discharge opening" is also met by the prior art. The prior art thus shows the limitation of "at least one seat element having the at least one spray discharge opening."

**FIG. 9**

Regarding Applicant's argument that Saikalis et al. do not indicate the feature of a swirl element arranged upstream from a seat element, it is agreed that Saikalis et al.

shows a valve seat formed in swirl element A, however, claim 19 does not positively recite a valve seat, but only a “seat element.” The swirl element A sits on the seating section of swirl insert B upstream of the seat section of B, and therefore meets the limitation of “a swirl element arranged upstream from the seat element.”

Applicant’s argument that one of ordinary skill in the art would understand a seat element to include a valve seat has been considered, however, since the prior art shows a seat element as stated above and the Applicant has not positively recited that their seat is actually a valve seat, the prior art meets the limitation of having a “seat element” as recited in claim 19.

In summary, if two parts are in contact with each other, as is the case with parts A and B of the Saikalis et al. reference, then one of the parts can be considered a seat for the other part as part B is to part A in this case. It is clear from Figures 8 and 9 that the element A sits on element B upstream of the seating section of B and that element B has a spray discharge opening 115. Saikalis et al. therefore meets all of the structural limitations of the instant invention as recited by the claims.

**Regarding the argument of the rejection of claims 21-26, 31, 34, 37, 38, 40, and 41 under 35 USC 103(a)**

Since the device of Saikalis et al. shows all of the structural limitations of the instant invention, the method of welding parts together or making parts detachable from each other would have been matters of design choice since it has been held that whether a product is patentable depends on whether it is known in the art or it is obvious and is not governed by whether the process by which it is made is patentable.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Davis Hwu/

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